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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,307	10/30/2003	Hisao Kamo	OMY-0032	6574

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EXAMINER
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LE, HOA VAN

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/696,307

Applicant(s)

KAMO, HISAO

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-11 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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This application is up for consideration.

A.1. Claims 1-11 are generic to a plurality of disclosed patentably distinct species comprising many possible "compounds having pKa...less than 12" as broadly disclosed in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed compound species for an initiation of a search, even though this requirement is traversed. Applicants is further requested and required to additionally provide compound chemical structure for a precise consideration and search by clearly and precisely disclosing (\*) all bonding connections between and among chemical atoms and (\*\*) positions of all chemical atoms in an elected compound species. No further examining process will be made until all requests and requirements are met. It is now notified for the record.

2. Claims 1-10 are generic to a plurality of disclosed patentably distinct species comprising several compounds of group A. Applicant is required under 35 U.S.C. 121 to elect a single disclosed compound species for an initiation of a search, even though this requirement is traversed.

3. Claims 8-11 are generic to a plurality of disclosed patentably distinct species comprising many possible neutralizing agent chemical structures as broadly disclosed in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed chemical structure species for an initiation of a search, even though this requirement is traversed. Applicants is requested and required to disclose a chemical structure for a precise consideration and search by clearly and precisely disclosing (\*) all bonding connections between and among chemical atoms and (\*\*) positions of all chemical atoms in the

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structure. No further examining process will be made until all requests and requirements are met. It is now notified for the record.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

B. Claims 6 and 7 are improper and are not considered since they are related to material claims but are mainly contained method of use embodiment claims. Any processing step of or intended use is not considered in a material claim. Applicants are requested and required to make a proper correction. No allowance of the specification will be indicated until a proper correction is made. It is now clearly pointed out, set forth and notified for the record.

C. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5, drawn to a solution, classified in class 430, subclass 466.
- II. Claims 6-7 (provisionally considered for a proper correction only), drawn to method of use, classified in class 430, subclass 403.
- III. Claims 8-10, drawn to a method of making a multiple solutions, class 430, subclass 450.

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IV. Claims 11, drawn to an agent-by-process of making (being broader than process, per se, in Group "III" above. Accordingly, it is required more and broader consideration and search since a processing step in a material claim is given a little to no value unit applicant shows a convincing evidence that the claimed step process would provide an unusual or unexpected result. At the level of one skilled in the art and to be commensurate in scope with the broadly claims, it would like to see a test result using 0.000 001 mol/l of an acid adducted color developing agent for a sufficient amount of a precipitation to be able to cause an adverse or deleterious solution. In the absence of convincing evidence, any argument alone is not factual evidence and would properly given a little to no value. It is now clearly, pointed out, set forth and notified for the record. However, if applicant elect this invention, a considered and search will be made. If this invention is found to be allowable over the prior art, claims 8-10 will be let to be rejoined only), class 564, at least 305+.

The inventions of Groups I and IV are all related to the materials but have the patentably different and distinct embodiments and have acquired the separate status and searches in the art and can be supported the separate patents as divided by applicants and have no evidence on the record that is not required the separate consideration and search since they are the obvious variants because the prior art being applied to one of them would be sufficient against all inventions, restriction for examination purposes as indicated is proper. Applicant should show or provide an evidence to the contrary. In the

absence of convincing evidence, the restriction would not be removed.

The inventions of Groups II and III are all related to the processes but have the patentably different and distinct steps and have acquired the separate status and searches in the art and can be supported the separate patents as divided by applicants and have no evidence on the record that is not required the separate consideration and search since they are the obvious variants because the prior art being applied to one of them would be sufficient against all inventions, restriction for examination purposes as indicated is proper. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

Because these inventions are distinct for the reasons given above and have acquired the separate status and searches in the art and can be supported the separate patents as divided by applicants and have no evidence of the record that are not required the separate consideration and search since they are the obvious variants because the prior art being applied to one of them would be sufficient against all inventions, restriction for examination purposes as indicated is proper. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

D. An additional consideration or search for more than one invention, class or subclass in the art is burdensome, lacks of focus on many and all issues in the claimed inventions and dilutes patentability of many and all issues in many inventions than those

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in one. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

F. Applicant is advised that the reply to this requirement to be complete must include an election as set forth on the record to be examined even though the requirement be traversed (37 CFR 1.143).

G. However any process claim is permitted to be rejoined with a material claim provided (a) that the material claim is allowable and (b) the process claim must be contained all of the limitations of the allowable material claim in accordance with the authority stated in *In re Ochiai*, 37 USPQ2d 1127 or *In re Brouwer*, 37 USPQ2d 1663 and MPEP 821.04.

H. Applicant is advised that the reply to this requirement to be complete must include full elections and requirements as clearly pointed out and set forth on the record to be examined even though the requirement be traversed (37 CFR 1.143).

I. Other issues have not been considered until full elections and requirements are met and resolved.

J. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332. The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le  
Primary Examiner  
Art Unit 1752

HVL  
11 August 2004

HOA VAN LE  
PRIMARY EXAMINER

A handwritten signature in black ink that reads "Hoa Van Le". The signature is written in a cursive, flowing style.